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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,611	06/23/2003	Kinya Aota	503.35255V12	9607

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EXAMINER
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STONER, KILEY SHAWN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,611

Applicant(s)

AOTA ET AL.

Examiner

Kiley Stoner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/820,231.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-23-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/600,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general language used in the two applications is equivalent language within the art. Application 10/600,576 teaches a backing plate which more specific than a backing member, so the backing member is envisioned by the backing plate. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Midling et al. (WO 95/26254). Midling et al. teaches A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 5a-5e). The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article.

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (5,460,317) of the IDS. Thomas et al. teaches A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said

structure body (Figures). The outer face of the structural body is relative to the direction in which the body is being viewed and does not structurally limit the article.

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by The 2<sup>nd</sup> International Forum of Aluminum Ships. The International Forum teaches A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figure 4); and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figure 4 and the title).

Claims 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Welding & Metal Fabrication. Welding & Metal Fabrication teaches A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding

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portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figure 1); and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figure 1 and page 4, column 1).

Claims 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Bulletin 6. Bulletin 6 teaches a structure body comprising: A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 3-4 and page 3, column 3); and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face

of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figures 3-4 and page 3, column 3).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Childress (5,862,975). Childress teaches a structure body comprising: A structure body, comprising: a first plate and a second plate, welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said structure body (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2); and a vehicle, comprising: a first plate and a second plate welded from one side, at a welding portion, in a thickness direction, by friction stir welding, a raised portion connected to said welding portion at said one side and projecting to said one side of said first plate, a face of a side of said welding portion opposed to said one side is formed substantially flat by the friction stir welding, and said face of said side opposed to said one side is arranged as an outer face of said vehicle (Figures 1-2; column 1, lines 13-18; column 2, lines 39-51 and claim 2).

**Conclusion**

The prior art of record that is cited as of interest is presented on the form-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KILEY S. STONER  
PRIMARY EXAMINER

*Kiley Stoner* 12/14/04